

RESPONSE UNDER 37 C.F.R. § 1.116
U.S. Appln. No. 09/874,314
Attorney Docket No. Q64575

REMARKS

Claims 1-2 are all the claims pending in the application.

Claims 1-2 have been rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Dobashi et al in view of EP 0273585.

Applicants respectfully traverse the rejection for at least the following reasons.

Dobashi et al discloses that the tackifier may be, *inter alia*, aliphatic, aromatic or alicyclic petroleum resins, and those modified by hydrogenation, i.e., aliphatic petroleum resins, aromatic petroleum resins, alicyclic petroleum resins, hydrogenated aliphatic petroleum resins, hydrogenated aromatic petroleum resins, and hydrogenated alicyclic petroleum resins. It is noted that copolymer petroleum resins are not included.

EP '585 discloses that in order to achieve the desired adhesive properties of an adhesive tape, the rubbers are generally tackified with a resin (page 3, line 5).

However, there is no indication in EP '585 that the tackifier used in EP '585 results in a similar (or better) adhesive properties to (or than) those of Dobashi et al. Accordingly, Applicants respectfully submit that there is no reasonable expectation that replacing the tackifier of Dobashi et al with that of EP '585 would result in an adhesive layer with desirable properties.

Furthermore, EP '585 discloses that a formulation having a higher solids content is desirable because it is possible to increase the efficiency of the coating process, and the reduction in the amount of solvent to be evaporated from the coated film has economic and environmental benefits (page 2, lines 15-18). For this reason, EP '585 does not disclose or suggest that using a specified tackifier results in the benefits mentioned above.

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Accordingly, Applicants respectfully submit that one of ordinary skill in the art would not have expected the above benefits by using the tackifier disclosed in EP '585 in the composition of Dobashi et al, contrary to the Examiner's assertion.

Still further, Applicants respectfully submit that any possible *prima facie* case would have been overcome by the evidence in the original application, supplemented with the additional declaration evidence of record. See page 4 of the Amendment filed January 30, 2004. In this regard, Applicants respectfully submit that the data in the specification and Declaration are sufficient to rebut any inference of *prima facie* obviousness.

Specifically, under MPEP 716.02(b), evidence of unexpected properties may be in the form of a comparison of the claimed invention with the closest prior art which is commensurate in scope with the claims. In the Inoue Declaration, the comparison was made by using the terpene resin. The terpene resin was used in all of the working Examples in Dobashi et al, and thus is the closest prior art example. Accordingly, Applicants respectfully submit that the Inoue Declaration satisfies the requirements and that the Examiner's position is improper.


In view of the foregoing, Applicants respectfully submit that the present invention is patentable over the cited references and the rejection should be withdrawn.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

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The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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